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170 Wood Avenue South
Iselin, NJ 08830

EXAMINER

NGUYEN, PHONG H

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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Application Number: 10/524,782
Filing Date: February 16, 2005
Appellant(s): TALANIS ET AL.

MAILED

FEB 13 2008

Technology Center 2100

John P. Musone
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed 11/16/2007 appealing from the Office action mailed 07/03/2007.

(1) Real Party in Interest

A statement identifying by name the real party in interest is contained in the brief.

(2) Related Appeals and Interferences

There is no other appeal, interference or judicial proceeding that is related to or that will directly affect, or that will be directly affected by, or that will have a bearing on the Board's decision in this Appeal.

(3) Status of Claims

The statement of the status of claims contained in the brief is correct.

(4) Status of Amendments After Final

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

(5) Summary of Claimed Subject Matter

The summary of claimed subject matter contained in the brief is correct.

(6) Grounds of Rejection to be Reviewed on Appeal

The appellant's statement of the grounds of rejection to be reviewed on appeal is correct.

(7) Claims Appendix

The copy of Appendix of appealed claims is minor error: missing status of canceled claims 1-18 and 38.

(8) Evidence Relied Upon

WO 01/18633 A1	Carpentier	03-2001
US 6,029,196	Lenz	02-2000

(9) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

Claim Rejections - 35 USC § 103

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. **Claims 19-37** are rejected under 35 U.S.C. 103(a) as being unpatentable over International Publication Number WO 01/18633 A issued to Paul R. Carpentier et al. ("Carpentier") in view of U.S. Patent Number 6,029,196 issued to Michael A. Lenz ("Lenz").

As per claim 19, Carpentier teaches *an apparatus being responsive to control operation of a device according to one or more of the files* (Carpentier discloses that automatic behavior may be added to a descriptor file that performs certain actions when a descriptor file is used to retrieve files e.g. automatically send electronic mail or publish on web sites at page 19 line 32 – page 20 line 3. Therefore, the descriptor file controls operation of a computer (device), which sends the emails or a web server (also a device), which publishes the web sites), *the apparatus including storage for storing the file directory* (Figure 17, #1026: Fixed disk is a storage for storing the file directory), *the file directory structure including:*

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a first hierarchy level and a second hierarchy level designed as a subordinate level of the first hierarchy level (page 16, lines 21-23: "Any number of folders and any hierarchy may be represented in the descriptor file"; page 25, line 4: "A hierarchy of folders may be created..." Therefore, any hierarchy of folders may include top-down hierarchy of folders, which contains a least a folder and a subfolder (subordinate folder));

a first file directory situated on the first hierarchy level (Figure 5, #310: Folder 310 is a first file directory);

a second file directory situated on the second hierarchy level (Figure 5, #342: Folder 342 is a second file directory. In addition, Carpentier teaches that any hierarchy of folders may include top-down hierarchy of folders, which contains a least a folder and a subfolder (second hierarchy level) as ground(s) of rejection set forth above); and

a first file situated on the first or the second hierarchy level or on a subordinate hierarchy level (Figure 5, #320 #344: File 320 or file 344 are first files), wherein

the file directory structure is held in a second file (page 16, lines 21-23: Any number of folders and any hierarchy (file directory structure) may be represented in the descriptor file (second file), wherein

each file directory and each file of the file directory structure is listed consecutively in the second file (Figure 5: Folder (Directory) Name 310, 342 and File Name 320, 340, 344 were represented in the descriptor file (second file)), wherein

each file directory and each file of the file directory structure is identified by at least one characteristic start symbol and/or at least one characteristic end symbol

(Figure 6A: folder "net" (every file directory), file "FtpClient.class", file "ftpInputStream.class", file "FtpLoginExcetion.class" and file "FtpProtocolException.class" (every file) are identified by characters "<" (characteristic start symbol) and "</" or ">" (characteristic end symbol)), and

wherein the contents of each file directory and each file in the file directory structure are stored in each case between the respective characteristic symbols (Figure 6A: contents of folder "net" and files "FtpClient.class", "ftpInputStream.class" and so on were stored between characters "<" and "</" or ">" (respective characteristic symbols)),

said file directory structure enabling the apparatus to operate as a web server (page 19, line 32 – page 20, line 3: automatic behavior may added to a custom descriptor file that perform certain actions, e.g. publication on web sites. Therefore, enabling the apparatus to operate as a web server, which publishes those web sites, is also taught by Carpentier), *thereby enabling remote access to control or change operation of the device* (page 40, lines 10-12: method embodiments of the present invention may execute over a network such as the Internet in conjunction with a remote CPU).

Carpentier does not explicitly teach the apparatus configured to receive files and updates thereto through a communication network, with files assembled in the file directory structure as claimed.

Lenz discloses the clients are configured to receive configuration files from the server through a communication network and those configuration files are assembled and resided in the file directory on the server (abstract).

Carpentier and Lenz are analogous art because they are from same field of endeavor of transferring files or data through communication network (page 1, lines 30-31 from Carpentier; and abstract from Lenz).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the apparatus of Carpentier with the teaching of Lenz because it would store any information about client in one file so a system administrator has ability to configure and update remotely every client in the network with one file (abstract from Lenz).

As per claim 20, Carpentier teaches *an Internet-compatible language is used for describing the file directory* (page 20, lines 4-5: descriptor file (second file) was written using an application of XML. XML also is an Internet compatible language).

As per claim 21, Carpentier teaches *the second file, in which the file directory structure is stored, is an XML file and the XML language is used for the purpose of description* (page 20, lines 4-5: descriptor file (second file) was written using an application of XML).

As per claim 22, Carpentier teaches *the XML language is used for the file directory structure* (page 20, lines 4-5: the descriptor file (second file) was written using an application of XML. The descriptor file contains the file directory structure, so XML language also is used for describing the file directory structure).

As per claim 23, Carpentier teaches *a new line is used both for each characteristic start symbol and for each characteristic end symbol in the second file* (Figure 6A: new line is used both for characteristic symbols "<", "</" and ">").

As per claim 24, Carpentier teaches *the designation of the relevant file directory or of the relevant file is used as a characteristic start symbol, and the designation of the relevant file directory or of the relevant file is used as a characteristic end symbol and a predeterminable character is added as a prefix* (Figure 6A: <eclipcontents>, </eclipcontents>, <hfm1>, </hfm1>, <folder>, </folder> are used as a characteristic start symbol and characteristic end symbol. This technique also is well-known in XML art).

As per claim 25, Carpentier teaches *the second file includes further sections having other contents, said further sections being identified or separated in each case by at least one characteristic start symbol and at least one characteristic end symbol* (page 19, lines 30-31: any relevant information (further sections having other contents) may automatically be added to the descriptor file).

As per claim 26, Lenz teaches *configuration data is stored in at least one of the further sections of the second file* (column 1, lines 58-60: The file contains information for setting the client's lock files, e.g. preferences, configuration information (configuration data)).

As per claim 27, Lenz teaches *result codes and/or error codes are stored in at least one of the further sections of the second file* (column 1, lines 58-60: The file contains information for setting the client's lock files, e.g. preferences (result codes and/or error codes), configuration information).

As per claim 28, Carpentier teaches *the apparatus comprises a mechanism for receiving and/or storing the second file via a communication network* (Figure 15, #968 and #970: Internet 968 and LAN 970 (Local Area Network) which is also Intranet. In addition, LAN may include "wireless" LAN which works over radio connection).

As per claim 29, Carpentier teaches *the communication network is the Internet and/or an Intranet and/or a radio connection* (Figure 15, #968 and #970: Internet 968 and LAN 970 (Local Area Network) that is also Intranet. Therefore, the communication network includes "wireless" LAN that works over radio connection is also taught by Carpentier).

As per claim 30, Lenz teaches *a configuration of the apparatus, using the configuration data which is present in the second file, can be carried out automatically after the second file has been loaded onto the apparatus* (Abstract, lines 7-12: the configuration file (second file) that is used by the client to configure its system and it is performed (carried out) automatically during runtime).

As per claim 31, Lenz teaches *the apparatus is coupled to a communication network* (abstract, lines 1-3: client (apparatus) is coupled to network and is updated by server) *and the device is a motor* (page 1, lines 15-17: Administrators maintain the operational integrity of the machines attached to the network. The machine is equivalent to a motor); and Carpentier teaches *the communication network taken from the group of an intranet, the internet and a radio-connected network* (Figure 15, #968 and #970: Internet 968 and LAN 970 (Local Area Network) which is also Intranet. In addition, LAN may include "wireless" LAN which works over radio connection).

As per claims 32 and 33, Lenz teaches *an update of the file directory structure and the configuration data can be carried out by overwriting an original file version of the second file with a new file version* (abstract: Server configured any client by only one file (second file) and the configuration includes updating any files, folders, file directory structure, configuration data and that configuration also can be carried out automatically by replacing (overwriting) the existing file by new file sent by server).

As per claim 34, Lenz teaches *after the second file has been updated, a previously set configuration data of the apparatus onto which the original file version of the second file was loaded, can automatically be checked and adapted* (abstract, lines 7-12: the configuration file (second file) that is used by the client to configure its system and it is carried out automatically during runtime. Therefore, that configuration data of

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the second file can automatically be checked and adapted before installing in device is also part of the teaching of Lenz).

As per claim 35, Carpentier teaches *the apparatus is an embedded device* (page 19, lines 18-19: This descriptor file includes meta data that identifies a software plug-in; page 39, lines 17-20: processor(s) are coupled to storage devices including memory (RAM and ROM). Therefore, Carpentier teaches a system (embedded system) consists a microcomputer/ processor with software in ROM, which starts running some special purpose application program, e.g. automatically send electronic mail or publish on web sites at page 19, line 32 – page 20, line 3).

As per claim 36, Carpentier teaches *the apparatus is an automation device* (page 37, lines 21-23: the MD5 may be generated automatically by a network device).

Claim 37 contains the same subject matters as claim 19. Therefore, it is essentially rejected for the same reason as discussed in claim 19 above.

(10) Response to Argument

i. Claim 19:

Regarding claim 19, appellant argued that the Carpentier reference for disclosing an apparatus being responsive to control operation of a device is misplaced. However, Carpentier discloses that automatic behavior may be added to a descriptor file that performs certain actions when a descriptor file is used to retrieve files e.g. automatically send electronic mail or publish on web sites at page 19, line 32 – page 20, line 3. Therefore, the descriptor file controls operation of a computer (device), which sends the emails or a web server (also a device), which publishes the web sites.

Appellant also argued Carpentier reference does not disclose any specific hierarchical relationships. However, Carpentier discloses that “any number of folders and any hierarchy may be represented in the descriptor file” at page 16, lines 21-23, and “a hierarchy of folders may be created...” at page 25, line 4. Therefore, any hierarchy of folders may include top-down hierarchy of folders, which contains at least a folder and a subfolder (subordinate folder).

Appellant also argued nothing in Figure 5 of Carpentier reference suggests that folder 310 and folder 342 are at different hierarchical levels. However, Carpentier teaches that any hierarchy of folders may include top-down hierarchy of folders, which contains at least a folder and a subfolder (different hierarchical levels) as ground(s) of rejection set forth above.

Appellant also argued folder 310 in Figure 5 of Carpentier reference cannot claim

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as first file situated on the first or the second hierarchy level. Examiner submits it is typo error. It should be read file 320 or file 344 in Figure 5 are first files.

Appellant also argued Carpentier reference never suggests every file and every file directory have the attribute of at least one characteristic start symbol and/or at least one characteristic end symbol. However, Carpentier teaches that folder "net" (every file directory), file "FtpClient.class", file "ftpInputStream.class", file "FtpLoginExcetion.class" and file "FtpProtocolException.class" (every file) are identified by characters "<" (characteristic start symbol) and "</" or ">" (characteristic end symbol) at Figure 6A. This technique is also well-known in the XML (Extended Markup Language) art.

Appellant also argued the descriptor file of Carpentier reference in Figure 6A does not include two levels of hierarchy and therefore cannot disclose a second directory on a second hierarchy level. However, Carpentier teaches that any hierarchy of folders may include top-down hierarchy of folders, which contains a least a folder and a subfolder (second hierarchy level) as ground(s) of rejection set forth above.

Appellant also argued the prior art does not teach, "an apparatus configured to receive [the] files ... through a communication network ... [for] enabling remote access to control or change operation of the device." However, Lenz discloses the clients (apparatus) are configured to receive configuration files from the server through a communication network and those configuration files are assembled and resided in the file directory on the server (abstract). In addition, Carpentier teaches enabling remote access to control or change operation of the device (page 40, lines 10-12: method

embodiments of the present invention may execute over a network such as the Internet in conjunction with a remote CPU).

In response to appellant's argument that the examiner's conclusion of obviousness is based upon improper hindsight reasoning, it must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the applicant's disclosure, such a reconstruction is proper. See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971).

In response to a appellant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, the motivation is from second reference Lenz (abstract): it would store any information about client in one file so a system administrator has ability to configure and update remotely every client in the network with one configuration file (descriptor file on first reference).

ii. Claim 35:

Regarding claim 35, appellant argued that the Carpentier reference does not teach the apparatus is an embedded device as claimed. However, Carpentier discloses this descriptor file includes meta data that identifies a software plug-in at page 19, lines 18-19, and processor(s) are coupled to storage devices including memory (RAM and ROM) at page 39, lines 17-20. Therefore, Carpentier teaches a system (embedded system) consists a microcomputer/ processor with software in ROM, which starts running some special purpose application program, e.g. automatically send electronic mail or publish on web sites at page 19, line 32 – page 20, line 3.

iii. Claim 36:

Regarding claim 35, appellant argued that the Carpentier reference does not teach the apparatus is an automation device as claimed. However, Carpentier teaches the apparatus is an automation device (page 37, lines 21-23: the MD5 may be generated automatically by a network device).

iv. Claims 20 – 34 and 37

Regarding claims 20 – 34 and 37, claims depend directly or indirectly from independent claims 19, are rejected as incorporating the deficiencies of independent claims upon which they depend and as ground(s) of rejection set forth above.

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(10) Related Proceeding(s) Appendix:

No decision rendered by a court or the Board is identified by the examiner in the Related Appeals and Interferences section of this examiner's answer.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

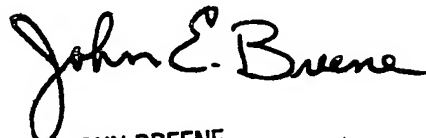
Phong H. Nguyen

Examiner



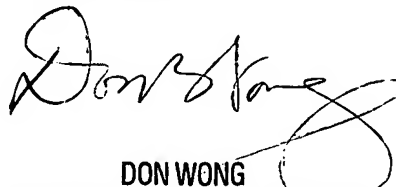
Conferees:

John Breene



JOHN BREENE
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 2100

Don Wong



DON WONG
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 2100